

Notice of Allowability**Application No.**

09/403,269

Examiner

David J Steadman

Applicant(s)

LINDAHL ET AL.

Art Unit

1652

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTO-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. This communication is responsive to *amendment filed October 02, 2003.*
 2. The allowed claim(s) is/are 21,25,33-35,38-43,47,55-57,60-65,67,68,72-85 and 103-115.
 3. The drawings filed on _____ are accepted by the Examiner.
 4. Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All
 - b) Some*
 - c) None of the:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).
- * Certified copies not received: _____.
5. Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
 - (a) The translation of the foreign language provisional application has been received.
 6. Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application. **THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

7. A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
8. CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) including changes required by the Notice of Draftperson's Patent Drawing Review (PTO-948) attached
1) hereto or 2) to Paper No. _____.
 - (b) including changes required by the proposed drawing correction filed _____, which has been approved by the Examiner.
 - (c) including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No. _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the margin according to 37 CFR 1.121(d).

9. DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|---|
| <input type="checkbox"/> Notice of References Cited (PTO-892) | <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | <input type="checkbox"/> Interview Summary (PTO-413), Paper No. _____. |
| <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No. _____ | <input type="checkbox"/> Examiner's Amendment/Comment |
| <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | <input type="checkbox"/> Other |

DETAILED ACTION

Status of the Application

[1] Claims 21, 25, 33-35, 38-43, 47, 55-57, 60-65, 67-68, 72-85, and 103-115 are pending in the application.

[2] Applicants' amendment to the claims filed October 02, 2003, is acknowledged.

This listing of the claims replaces all prior listings and versions of the claims.

Claim Rejections - 35 USC § 101

[3] In view of applicants' amendment to claims 80 and 107, the rejection under 35 U.S.C. § 101 as set forth in item 6 of the Office action mailed July 10, 2003, is withdrawn.

Claim Rejections - 35 USC § 112, Second Paragraph

[4] In view of applicants' amendment to claims 65, 67, 68, 72-75, and 80, the rejection under 35 U.S.C. § 112, second paragraph as set forth in item 7 of the Office action mailed July 10, 2003, is withdrawn.

Claim Rejections - 35 USC § 112, First Paragraph

[5] In view of applicants' arguments and upon reconsideration of the new matter rejection of claims 65, 68, 72, 73, 75-85, and 115 under 35 U.S.C. § 112, first paragraph, as set forth in item 8 of the Office action mailed July 10, 2003, is withdrawn.

Applicants have sufficiently pointed out support for the recited nucleic acid endpoints in the specification.

[6] In view of applicants' amendment to claim 7, the written description and scope of enablement rejections of claim 107 under 35 U.S.C. § 112, first paragraph, as set forth in items 9-10 of the Office action mailed July 10, 2003, are withdrawn.

Double Patenting

[7] As acknowledged by applicants', MPEP § 804 states, "[t]he 'provisional' double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. As this is the only remaining rejection in the instant application, the obviousness-type double patenting rejection of claims 21, 33-35, 38-43, 55-57, and 60-64 is withdrawn.

Reasons for Allowance

[8] The following is an Examiner's statement of reasons for allowance. The examiner can find no teaching or suggestion in the prior art directed to an isolated polynucleotide encoding the glucuronyl C5-epimerase of SEQ ID NO:13, including SEQ ID NO:12, and variants and fragments thereof encoding a glucuronyl C5-epimerase polypeptide as encompassed by the claims. Therefore, claims 21, 25, 33-35, 38-43, 47, 55-57, 60-65, 66-68, 72-85, and 103-115 24-25, directed to an isolated polynucleotide encoding SEQ ID NO:13, the polynucleotide of SEQ ID NO:12, and nucleic acid variants and fragments

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thereof encoding a glucuronyl C5-epimerase, host cells, and methods of making a polypeptide as encompassed by the claims are allowable over the prior art of record.

[9] Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The Examiner can normally be reached Monday-Friday from 7:00 am to 5:30 pm. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Ponnathapura Achutamurthy, can be reached at (703) 308-3804. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman, Ph.D.
Patent Examiner
Art Unit 1652

Rubena Lewis
Rubena Lewis
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